

ESTTA Tracking number: **ESTTA616069**

Filing date: **07/16/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058839
Party	Defendant Wine Dive, LLC
Correspondence Address	CARL J SPAGNUOLO MCHALE & SLAVIN PA 2855 PGA BOULEVARD PALM BEACH GARDENS, FL 33410 UNITED STATES cspagnuolo@mchaleslavin.com
Submission	Other Motions/Papers
Filer's Name	Carl J. Spagnuolo
Filer's e-mail	cspagnuolo@mchaleslavin.com, ustrademarks@mchaleslavin.com
Signature	/Carl J. Spagnuolo/
Date	07/16/2014
Attachments	~OTEH5JI001F.PDF(996109 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LE REVE VENTURES, LLC,	:	
a Texas limited liability company,	:	
	:	Cancellation No. 92058839
Petitioner	:	
	:	Registration No. 4,283,391
v.	:	
	:	
WINE DIVE, LLC,	:	
a Florida limited liability company,	:	
	:	
Registrant.	:	
_____	:	

**REGISTRANT’S OPPOSITION TO PETITIONER’S
MOTION TO AMEND PETITION FOR CANCELLATION**

Registrant, Wine Dive, LLC, by and through its undersigned attorneys, opposes the Petitioner’s Motion to Amend Petition for Cancellation because Petitioner’s purpose in seeking to amend the Petition arises in bad faith, and the objective of the Amended Petition would be futile.

The Registrant recognizes that the Petitioner’s Motion to Amend its Petition is within the time allowed for doing so by the rules governing actions before the Board and that the policy of Fed.R.Civ.P. 15(a) favors allowing the amended pleading, as explained in Foman v. Davis 3712 U.S. 178 (1962). As qualified in Foman however, the right is not automatic and factors such as undue delay, bad faith, dilatory motive or futility of the amendment may justify the denial of such a motion.

FUTILITY OF THE ADDED BASIS FOR CANCELLATION

The Petitioner’s Amended Petition for Cancellation contains narrow amendments which are limited to an allegation of “fraud” purportedly committed by the Registrant against the

Trademark Office. While Petitioner's assertion is disputed, even if it were true, it would render the amended basis for cancellation futile.

The Petitioner's Amended Petition for Cancellation alleges that the specimens relied upon by Registrant to gain registration were either "materially misleading," "not representative of Registrant's use of the Mark in commerce," "was doctored", or were otherwise fraudulently manufactured. They were not. Nevertheless, even if they were, other acceptable, bone fide specimens were available and in use in commerce before the expiration of the deadline for filing the statement of use. 37 C.F.R. §2.59(b) states that, "[i]f the applicant files at least one specimen with the statement of use, but the specimen is unacceptable, the applicant may provide a substitute specimen *after the expiration of the time permitted for filing the statement of use*, provided that the applicant verifies that the substitute specimen was in use in commerce before the expiration of the deadline for filing the statement of use." (emphasis added).

In this case, the Registrant had a number of items from which to select as a specimen. While the Registrant may have not selected the best of specimens available, the specimens submitted were valid. However, other specimens were available at the time of the filing of the Statement of Use but were overlooked. According to 37 C.F.R. §2.59(b), the Registrant is free to amend the prosecution record of its trademark and enter a substitute specimen now, which is clearly "after the expiration of the time permitted for filing the statement of use," because the substitute specimen(s) available for filing were in use in commerce before the expiration of the deadline for the filing of the statement of use. Accordingly, the Registrant is filing, simultaneously with this Response Brief, a Declaration of Substitute and Supplemental Specimen comprising a "welcome mat" which has been at the threshold of the Registrant's establishment since opening day sometime in late December, 2011 and remains there today. Therefore, the allegation of fraud is absolutely futile.

Even more damaging to Petitioner's attempt to add an allegation of "fraud," and wholly demonstrating that its fraud allegation is futile, is the fact that the proposed Petition is legally insufficient to support the fraud claim. "Pleadings of fraud made 'on information and belief' where there is no separate indication that the pleader has actual knowledge of the facts supporting a claim of fraud also are insufficient." Societe Cooperative Vigneronne Des Grandes Caves Richon-Le-Zion and Zicron-Jacob LTD v. Albrecht Piazza, LLC (Opposition No. 91190040 TTAB 2009). The allegations in the proposed amended pleading, upon which Petitioner's Motion are based, occur on "information and belief." The pleader fails to allege any actual knowledge of facts to support a claim of fraud. As stated by the Board in Societe, supra, such attempts at pleading fraud are wholly insufficient.

Petitioner's Motion, which incorporates the proposed Amended Petition For Cancellation, contains the following statements as the basis for its fraud allegation:

13. On information and belief, in the Statement of Use filed in its U.S. Trademark Application, Serial No. 85/136,746, a copy of which is attached hereto as Exhibit A (the "Statement of Use"), Registrant made false, material representations with the intent to deceive the USPTO when it stated that the applied-for mark was in use in commerce, when it was not, and provided materially false and misleading photographs to the USPTO as specimens in support of its application.

14. On information and belief, at the time of the filing of the Statement of Use, Registrant was not using the Mark in commerce. Instead, Registrant was and is operating its restaurant under the mark and logo "The Wine Dive" depicted on Exhibit B (the "Wine Dive Logo"), which does not include the word "Snooty's". On information and belief, Registrant has never used, and does not currently use, the Mark in commerce."

15. On information and belief, Registrant submitted three photographs as specimens to the USPTO to purportedly demonstrate Registrant's use of the Mark in commerce. The first specimen, a photograph of a wall in Registrant's restaurant, as shown in Section 1 to Exhibit C (the "First Specimen"), was materially misleading; the second specimen, a photograph of Registrant's menu, as shown in Section 1 to Exhibit D (the "Second Specimen"), was not representative of Registrant's use of the Mark in commerce; and the third specimen, a photograph of a metal sign in Registrant's restaurant, as shown in Section 1 to Exhibit E (the "Third Specimen"), was doctored and not

representative of the actual sign used in Registrant's restaurant before or after the date of the Application.

19. On information and belief, the Second Specimen was not indicative of Registrant's actual use of the Mark in commerce. As demonstrated by the photographs set forth in Section 2 to Exhibit D, showing the menu from December 2011 just before Registrant's restaurant opened as well as the current dinner menu on Registrant's website, the Mark was not used on either menu; instead, each such menu shows the words "The Wine Dive" without the word "Snooty's". Mr. Grice described the Second Specimen as "a pdf depicting the Snooty's Wine Dive Bar and Restaurant's Menu"; however, the images of the actual menu suggest that the Second Specimen was not a depiction of Registrant's actual menu and not indicative of Registrant's use of the Mark in commerce. Therefore, Mr. Grice's description with respect to the Second Specimen was false.

Petitioner's Motion To Amend (*emphasis added*).

In five independent paragraphs, Petitioner's Motion relies on the incantation "[o]n information and belief" to "justify" its allegations of fraud. Yet, in each of those five assertions, the Motion fails to allege any actual knowledge of facts to support a claim of fraud. As demonstrated through the Registrant's Declaration of Supporting Use of Substitute and Supplemental Specimen, and the specimen to which that declaration pertains, the Petitioner lacks actual knowledge of the facts necessary to support a sufficient basis to support a claim of fraud. Consequently, allowing the Petitioner's amended pleading would be futile.

THE PETITIONER'S MOTION OCCURS IN BAD FAITH

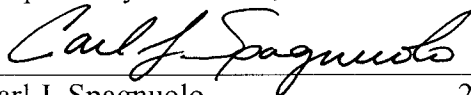
The Petitioner's Motion to Amend its Petition for Cancellation is also based in bad faith. The Petitioner had the current "Amended Petition for Cancellation" alleging fraud, fully prepared at least as early as March 11, 2014, but deliberately chose not to file it. Instead, Petitioner withheld its filing in order to threaten the Registrant with its potential filing in a bad-faith, coercive manner. It did so by demanding that Registrant both surrender its federal registration and cease using a substantive portion of its mark, or else Petitioner would alter its position against Registrant and allege fraud, "publically attacking [Registrant's] bona fides in the Cancellation Action." (See letter from Petitioner's counsel, attached as Exhibit A).

The true motive of Petitioner in these actions, including the increased coercion by threatening to allege fraud, is that Petitioner is actively and aggressively expanding geographically and opening new locations under the “MAX’S WINE DIVE” name. (*see* printout of Petitioner’s website attached as Exhibit B). In so expanding, it is evident that Petitioner recognizes there are many other “WINE DIVE” restaurants, including Registrant’s. (*see* website printouts from other “Wine Dive” establishments attached as composite Exhibit C). Upon belief, Petitioner is under pressure by either shareholders, potential franchisees, investors, or all three, to secure all rights to “WINE DIVE.” Further to that motive, Registrant has learned that Petitioner has sent “cease & desist” letters to other “WINE DIVE” establishments. It should be noted that Petitioner’s actual trademark used to identify its chain of establishments is “MAX’S WINE DIVE,” not just “WINE DIVE.” (*see* Affidavit of Abby Cox attached as Exhibit D). Petitioner seeks registration of “WINE DIVE” not because that is the stand-alone trademark it presently uses, has ever used, or intends to use, but rather because it recognizes it *must* secure the stand-alone phrase “WINE DIVE” unto itself if it intends on further expansion, financial funding, and perhaps franchising.

CONCLUSION

It is submitted that the proposed amended Petition For Cancellation should be denied as it was brought by Petitioner in bad faith. Separately, the proposed amended petition would be futile. For the reasons submitted in this opposition, the Board is asked to deny the Petitioner’s Motion to Amend Petition For Cancellation.

Respectfully submitted,




Carl J. Spagnuolo
McHale & Slavin, P.A.
Attorneys for Registrant

2855 PGA Boulevard
Palm Beach Gardens, Florida 33410
(561) 625-6575 F: (561) 625-6572
cspagnuolo@mchaleslavin.com

CERTIFICATE OF FILING AND SERVICE

I HEREBY CERTIFY that the foregoing Response to Petition for Cancellation was filed electronically with the Trademark Trial and Appeal Board using the ESTTA filing system, on July 16, 2014. Notice of this filing will be sent to counsel for all parties by email and U.S. Mail to the following Address:

Sheila Fox Morrison
Davis, Wright, Tremaine, LLP
1300 SW Fifth Avenue, Suite 2400
Portland, Oregon 97201
sheilafoxmorrison@dwt.com



Carl J. Spagnuolo

EXHIBIT A



Suite 2400
1300 SW Fifth Avenue
Portland, OR 97201-5610

Sheila Fox Morrison
(503) 778-5311 tel
(503) 778-5299 fax

sheilafoxmorrison@dwt.com

March 11, 2014

Via UPS

Sandra Lawson
Wine Dive, LLC
319 Clematis Street
West Palm Beach, Florida 33401

COPY

With a copy to:
Timothy L. Grice
Law Office of Timothy L. Grice, PA
319 Clematis Street
West Palm Beach, Florida 33401

Re: Unauthorized Use of the WINE DIVE Trademark

Dear Ms. Lawson:

We represent Le Reve Ventures, LLC, a Texas limited liability company dba Max's Wine Dive ("Le Reve") with regards to its intellectual property matters. Le Reve operates six Max's Wine Dive restaurants in Texas, with additional restaurants slated to open nationwide. First opened in December 2006, Max's Wine Dive restaurants are widely recognized for their unique approach to fine wine and comfort food, and Le Reve has invested significant time and resources in building its brand. Le Reve has developed strong consumer recognition of the marks MAX'S WINE DIVE and WINE DIVE, and owns an incontestable federal registration for the name MAX'S WINE DIVE for bar and restaurant services (Reg. No. 3,309,972).

We understand that you have been operating a restaurant under the name "The Wine Dive" since January 2012.

Your use of a name "The Wine Dive" in connection with bar and restaurant services is an infringement of Le Reve's trademark rights. The use of a name that is so similar to Le Reve's WINE DIVE and MAX'S WINE DIVE marks is likely to cause consumer confusion or mistake as to the source of your services, and to lead consumers to mistakenly believe you are endorsed by or otherwise affiliated with Le Reve, which you are not.

Accordingly, we insist that you change the name of your bar and restaurant to something that does not include Le Reve's WINE DIVE trademark.

DWT 23524936v3 0099516-000002

Anchorage
Bellevue
Los Angeles

New York
Portland
San Francisco

Seattle
Shanghai
Washington, D.C.

www.dwt.com

Sandra Lawson
Wine Dive, LLC
March 11, 2014
Page 2

Furthermore, we understand that you have obtained a federal trademark registration for the mark SNOOTY'S WINE DIVE (Reg. No. 4,283,391) for bar and restaurant services. However, we believe you are not and have never operated your restaurant under the SNOOTY'S WINE DIVE mark and are therefore not entitled to a federal registration of the mark.

Each of the specimens of use you submitted to the United States Patent and Trademark Office (USPTO) in support of your registration appears to be manipulated, doctored or described in a way that would lead the Trademark Examiner to erroneously believe your mark is "Snooty's Wine Dive" when it is not. We believe we have sufficient evidence to show that you knowingly made a false material representation to the USPTO. That said, my client is not particularly interested in publically attacking your bona fides in the cancellation action. Accordingly, we have filed to cancel your federal registration claiming likelihood of confusion only. Your service copy of the Petition to Cancel is attached.

We are willing to withdraw this action without prejudice if you confirm that you will voluntarily withdraw the SNOOTY'S WINE DIVE trademark registration and change your name. However, if you will not voluntarily withdraw the SNOOTY'S WINE DIVE trademark registration and change your name, we will file an amended cancellation petition claiming fraud on the USPTO. A copy of the draft Amended Petition to Cancel is attached.

Please confirm that you will cooperate by **March 25, 2014**, and then we can discuss a reasonable timeline for your transition to a new name and withdrawal of your registration.

If you refuse to cooperate we will proceed with the amended cancellation petition, and Le Reve reserves all rights and remedies arising out of your actions in this matter.

Very truly yours,

Davis Wright Tremaine LLP



Sheila Fox Morrison

Enclosures

cc: Le Reve Ventures, LLC

EXHIBIT B



<http://maxwinedive.com>

Restaurant & Wine Bar Pain...

MAX'S

WINE DIVE

"FRIED CHICKEN AND CHAMPAGNE? ...W"

LOCATIONS ABOUT PRESS + AWARDS EMPLOYMENT CONTACT GUEST FEEDBACK

- ATLANTA - 12th St.
- AUSTIN - San Jacinto Blvd.
- CHICAGO - N. Milwaukee Ave.
- DALLAS - McKinney Ave.
- DENVER - Opening 2014
- FORT WORTH - W. 7th St.
- HOUSTON - Fairview St.
- HOUSTON - Washington Ave.
- SAN ANTONIO - E. Basse Rd.

EMIGRATIONIST



"Your team in Austin took care of over 50 people in our party in your lower rooms. GREAT CUSTOMER SERVICE, FOOD WAS EXCELLENT, and of course the overall atmosphere WAS PERFECT. ...your folks handled everything very well."

Chloe's Bridal
503 Avenue (Houston area only)



EXHIBIT C

LOUIE'S
WINE DIVE

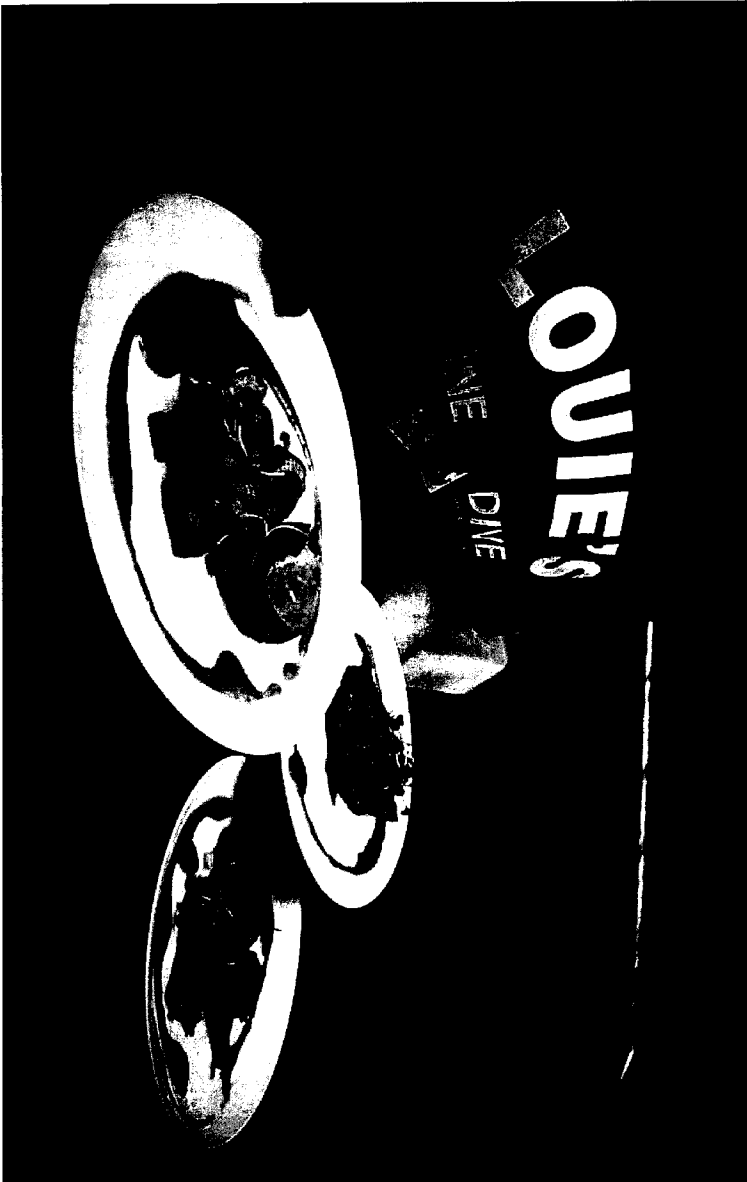
HOME MENUS AWARDS & REVIEWS SOCIAL FUN CONTACT US

FOLLOW US



Purchase Gift Cards

RESERVATIONS





http://www.mikeswinedive.com/



The Wine Dive | Wichita, Ka...



File Edit View Favorites Tools Help



FOOD MENU | DRINK MENU

WINE DIVE

NEWS & EVENTS | CONTACT



WINE DIVE SPECIALS We are open for lunch. Same great sandwiches and salads but a lower price just for lunch!





Reservations:
661.39.WIKIS (399.4547)

Where Ming and Buena Vista Intersect

MON - THU: 11AM - 10PM • FRI - SAT: 11AM - 11PM • SUN: 11AM - 9PM

[Home](#) [About Us](#) [Menu](#) [Giving Back](#) [Live Music & Events](#) [Photos](#) [Contact](#)

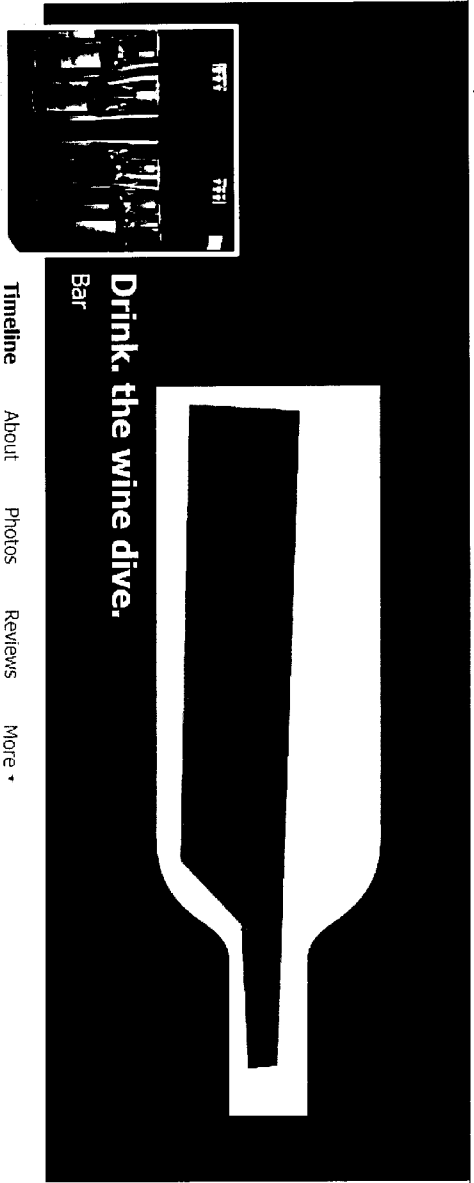


**Bakersfield's Only Casual Gourmet
Restaurant and Wine Bar!**

Join our E club!

Sign up for the latest news and special deals

email address



Drink. the wine dive.
Bar

- Timeline
- About
- Photos
- Reviews
- More

PEOPLE

546
811

ABOUT

KNOXVILLE

Chocolate Peanut Butter Porter....you know you want one!

Drink. the wine dive.



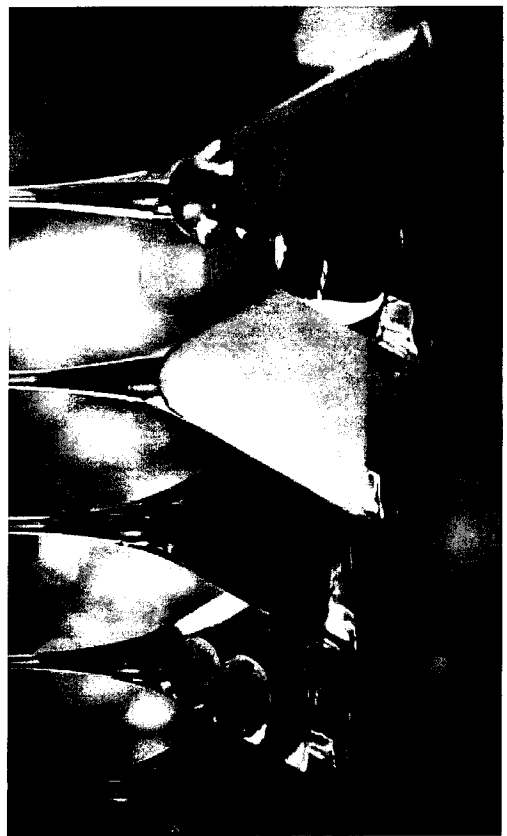
drink.

at bistro by the cracks

- HOME
- ABOUT
- DRINKS
- FOOD
- NEWS/EVENTS
- CONTACT



FOLLOW US
ON FACEBOOK



WELCOME TO DRINK -
KNOXVILLE'S PREMIER ENOLOGY
BAR.
FIND OUT MORE ABOUT US >

NEWS

WINE LETTERS
Mavaro, Mourvedre, Nonasutrali,
don't let the label confuse
you. These grapes are all the
same it's just the way it's
said in Australia, France &
Spain that's the difference.
In addition to making red
varietal wines, Mourvedre is

EXHIBIT D

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LE REVE VENTURES, LLC, a Texas limited
liability company,

Petitioner

v.

WINE DIVE, LLC, a Florida limited liability

Registrant.

Cancellation No. 920528839

Registration No. 4,283,391

SWORN AFFIDAVIT OF ABBY COX

I, ABBY A. COX, swear and affirm as follows:

1. That I am a Legal Assistant at the firm of McHale & Slavin, P.A. The firm is counsel for Registrant, WINE DIVE, LLC in the above-styled action. I make this Declaration in connection with the above-styled cancellation action filed by Petitioner, LE REVE VENTURES, LLC.

2. I am a citizen of the State of Florida, residing and domiciled in Palm Beach County, Florida. I am over the age of 18 years.

3. On May 14, 2014, I telephoned each of the eight (8) locations of Max's Wine Dive listed on the company's website at www.maxswinedive.com.

4. Due to the time difference, two of the six locations, the Washington Street location in Houston, Texas, and the McKinney Avenue location in Dallas, Texas were closed and I received a recorded message stating that I had reached "Max's Wine Dive".

5. Two of the locations, one in Chicago, Illinois and one in Atlanta, Georgia, have apparently not yet opened, however, a telephone call to the telephone numbers listed for each of those locations is answered by a recording that states I had reached "Max's Wine Dive".

6. When I telephoned the E. Basse Road location in San Antonio, Texas, the person who answered the telephone stated "Max's Wine Dive".


7. When I telephoned the Fairview Street location in Houston, Texas, the person who answered the telephone stated "Max's and Munchies".

8. When I telephoned the W. 7th Street location in Fort Worth, Texas, the person who answered the telephone stated "Max's Wine Dive".

9. When I telephoned the San Jacinto Blvd. location in Austin, Texas, the person who answered the telephone stated "Max's".

I swear or affirm that the above and foregoing representations are true and correct to the best of my information, knowledge and belief.

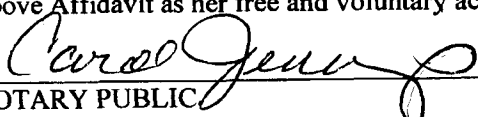
Dated: May 16, 2014



ABBY A. COX

STATE OF FLORIDA)
) ss
COUNTY OF PALM BEACH)

I, the undersigned Notary Public, do hereby affirm that Abby A. Cox personally appeared before me on this 16th day of May, 2014, and signed the above Affidavit as her free and voluntary act and deed.



NOTARY PUBLIC
State of Florida

My Commission Expires:



CAROL JENNINGS
MY COMMISSION # EE 207350
EXPIRES: July 7, 2016
Bonded Thru Budget Notary Services